

Application No. 10/074,364
Amendment dated June 1, 2004
Reply to Final Office Action dated May 11, 2004

Remarks/Arguments

This paper is being filed in response to the Final Official Action of the Examiner mailed May 11, 2004, setting a three-month shortened statutory period for response ending August 11, 2004. Claims 1-2, 4-6 and 9-31 remain pending. Reconsideration, examination and allowance of all pending claims are respectfully requested.

The undersigned would like to thank the Examiner for reviewing the Proposed Amendment-After-Final send on June 1, 2004. On June 1, 2004, the Examiner indicated that the application would be in condition for allowance after the filing of this Amendment-After-Final.

In paragraph 2 of the Final Office Action, the Examiner rejected claims 12-23 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With respect to claim 12, the Examiner states that it is not clear what the claimed "relatively uniform light output" is. Claims 13-23 were rejected for their dependency on claim 12.

In response claim 12 has been amended to recite:

12. (Currently Amended) A lighting apparatus adapted for use with a stair or other ledge, comprising:

an elongated member having a cavity with a length, the cavity being at least partially defined by a first material that is at least partially transparent which extends from the cavity to a first outer surface of the elongated member; and
an elongated light source extending along at least a major length of the cavity, the elongated light source providing a non-interrupted continuous relatively uniform light output emission along at least a major length of the elongated light source.

As can be seen, claim 12 now recites that the elongated light source providing a non-interrupted

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continuous light emission along at least a major length of the elongated light source. It is believed that this language fully complies with 35 U.S.C. § 112, second paragraph. As such, dependent claims 13-23 are also believed to fully comply with 35 U.S.C. § 112, second paragraph.

In paragraph 3 of the Office Action, the Examiner rejected claims 11-20 under 35 U.S.C. § 102(b) as being anticipated by Nagano (U.S. Patent No. 5,430,627). With respect to claim 11, and in paragraph 11 of the Office Action, the Examiner states that Merriam Webster's Collegiate Dictionary, 10ed., defines monolithic as:

2 a: cast as a single piece <a *monolithic* concrete wall>
...
2 c: consisting of or constituting a single unit
...

The Examiner states that the only applicable definitions are 2a (cast as a single piece) and 2c (consisting of or constituting a single unit). The Examiner states that the first and second portions of Nagano are held together by mechanical means and form a single unit, and thus meet the *monolithic* requirement as stated by definition 2c above.

In response, claim 11 has been amended to recite:

11. (Currently Amended) A lighting apparatus for receiving an elongated light source, comprising:

a monolithic elongated member formed as a single piece, including a first material that is at least partially transparent a second material that is at least substantially non-transparent, the monolithic elongated member having a cavity that extends along the length of the elongated member for receiving the elongated light source, the cavity being at least partially defined by the first material that is at least partially transparent and which extends to an outer surface of the housing.

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As can be seen, claim 11 now recites a monolithic elongated member formed as a single piece.

Nagano clearly does not suggest a monolithic elongated member formed as a single piece, but rather as the Examiner notes, Nagano suggests a first and a second portion that are held together by mechanical means.

As noted by the Examiner, and as further discussed in Applicants Response filed on December 15, 2003, Nagano teaches to provide "removable translucent covers" (see Nagano, Abstract, line 4). The "removable" nature of the translucent covers appears to be necessary to initially install, and then subsequently maintain, the string light fixtures secured within the channels. As such, there would appear to be no motivation whatsoever to make the light fixture housing and the removable translucent covers of Nagano a monolithic elongated member formed as a single piece. In fact, it would appear to work against the structure of Nagano as it would make it difficult or impossible to replace any damaged or burned out lights. For these and other reasons, claim 11 is believed to be clearly patentable over Nagano. For similar and other reasons, newly presented dependent claim 31 is also believed to be clearly patentable over Nagano.

Regarding claim 12, the Examiner states that the light source disclosed by Nagano is a number of point-light sources (as evidenced in column 1, lines 26-29). The Examiner takes the position that the series of point-light sources of Nagano meets the "relatively uniform light output" language of claim 12, especially in combination with the translucent cover lens (citing reference numbers 43, 45, 143 and 245).

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First, Applicant respectfully point out that claim 12, prior to the current amendment, recited an elongated member that includes: (1) a first material that is at least partially transparent which extends from the cavity to a first outer surface of the elongated member; and (2) an elongated light source extending along at least a major length of the cavity, the elongated light source providing a relatively uniform light output along at least a major length of the elongated light source. Presumably, the Examiner is equating the translucent cover lens of Nagano with (1) above, which is included in the elongated member. As such, Applicant does not believe it is proper for the Examiner to treat the translucent cover lens as also part of the elongated light source, as the Examiner appears to be doing.

In any event, and to overcome the rejection under 35 U.S.C. § 112, second paragraph, claim 12 has been amended to recite:

12. (Currently Amended) A lighting apparatus adapted for use with a stair or other ledge, comprising:
an elongated member having a cavity with a length, the cavity being at least partially defined by a first material that is at least partially transparent which extends from the cavity to a first outer surface of the elongated member; and
an elongated light source extending along at least a major length of the cavity, the elongated light source providing a non-interrupted continuous relatively uniform light output emission along at least a major length of the elongated light source.

As can be seen, claim 12 now recites that the elongated light source provides a non-interrupted continuous light emission along at least a major length of the elongated light source. As noted by the Examiner, Nagano teaches to use a number of point-light sources (as evidenced in column 1, lines 26-29). A number of point-light source, however, do not provide a non-interrupted

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continuous light emission along at least a major length of the elongated light source, as now recited in claim 12.

As noted by the Examiner above, and as further detailed in Applicants Response filed on December 15, 2003, Nagano suggests using a string of light bulbs. More specifically, Nagano states:

The preferred lighting fixture 61 is that disclosed in U.S. Pat. No. 5,045,981, incorporated by reference herein and shown in more detail in FIG. 9. Briefly, this light fixture employs a light bulb 62 inserted in a socket which is releasably secured to a carriage 63. The electrical contact to a pair of leads on the light bulb 62 is made by a pair of arcuate terminals fastened within the carriage 63. The terminals have one free end so that they may bend freely upon insertion of the socket within the carriage. The socket includes a depression configured to conform to the shape of the arcuate terminals, so that the terminals snap into the depression when the socket is inserted into the carriage 63. The leads extend across the depression to improve the electrical contact. The socket is further secured to the carriage 63 by a pair of grooves which mate to the carriage's guiding rails.

According to the preferred embodiment, the lamp carriage 63 is attached to the base 171 of a metal wedge clip carriage 173, e.g., by gluing. The wedge clip carriage 172 includes two wings 172, 174 attached to the respective edges of the base and extending outwardly therefrom. The wings 172, 174 are springably attached to the base such that they may bend in an arc 176 about the position shown in FIG. 10a.

FIGS. 10a-10d illustrate how the wedge clip carriage 173 is inserted into and retained by a cooperating channel such as 129. In FIG. 10a, the wedge clip carriage 173 is about to be inserted into the channel 129. In FIG. 10b, the wedge clip carriage 173 is initially being inserted into the channel 129, and the wings 172, 174 are being slightly forced inward against their bias towards the light fixture 61. In FIG. 10c, the wedge clip carriage 173 is almost completely inserted into the channel 129, and the wings 172, 174 have been forced inward by tangs 131, 133 located on a pair of relatively rigid interior channel walls 132, 134. FIG. 10d illustrates the wedge clip lamp carriage 173 completely inserted, in which position the wings 172, 174 have released outwardly against the walls 132, 134 and beneath the tangs 131, 133.

With respect to channel 129, it will be observed, for example, from FIG.

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10e, that the tangs 131, 133 are raised above the base of the channel 129 to a height sufficient such that the base 171 of the wedge clip carriages 173 will not bottom out as the spring clip sides or wings 172, 174 are pinched in by the tangs 131, 133, thereby permitting the carriages 173 to be snapped into the channel 129.

(Nagano, column 3, line 61 through column 4, line 40). As can be seen, Nagano suggests using a number of point light sources (i.e. light bulbs). In addition, much of the structure of Nagano is provided to accommodate the series of point light sources (see, for example, Figures 9, 10a-10d and 13 of Nagano). Therefore, Applicant does not believe it can readily be argued that it would have been obvious to replace the point light sources of Nagano, including all of the supporting structure which appears to be a main thrust of Nagano's disclosure, with an elongated light source that provides a non-interrupted continuous light emission along at least a major length of the elongated light source, as now recited in claim 12.

Applicant would like reiterate that although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." *In re Mills*, 916 F.2d at 682, 16 USPQ2d at 1432 (see, MPEP §2143.01). In the present case, there is no suggestion or motivation whatsoever in Nagano to replace the point light sources of Nagano, including all of the supporting structure which appears to be a main thrust of Nagano's disclosure, with an elongated light source that provides a non-interrupted continuous light emission along at least a major length of the elongated light source, as now recited in claim 12. For these and other reasons, claim 12 is believed to be clearly patentable over Nagano. For similar and other reasons, dependent claims 13-23 are also believed to be

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clearly patentable over Nagano.

In paragraph 5 of the Final Office Action, the Examiner indicated that claims 1, 2, 4-9, 10 and 24-30 are allowed.

In paragraph 6 of the Final Office Action, the Examiner indicated that claim 23 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. § 112, second paragraph, and to include all of the limitations of the base claim and any intervening claims. For the reasons discussed above, independent claim 12 is believed to be in condition for allowance. For similar and other reasons, dependent claim 23 is also believed to be in condition for allowance.

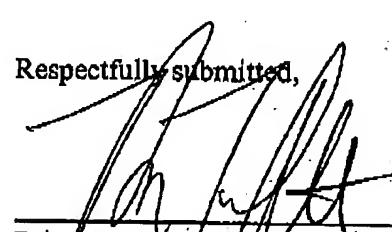
In paragraph 7 of the Final Office Action, the Examiner indicated that claim 31 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. For the reasons discussed above, independent claim 11 is believed to be in condition for allowance. For similar and other reasons, dependent claim 31 is also believed to be in condition for allowance.

In view of the foregoing, Applicant believes that all pending claims 1-2, 4-6 and 9-31 are now in condition for allowance. Reexamination and reconsideration are respectfully requested. If the Examiner believes it would be beneficial to discuss the application or its examination in any way, please call the Applicant at (612) 573-2002.

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Respectfully submitted,

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